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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,779	01/16/2004	David B. Small	9968-23U1	6327

570 7590 01/25/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

CHENG, JOE H

ART UNIT PAPER NUMBER

3715

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/758,779	<b>Applicant(s)</b> SMALL ET AL.	
	<b>Examiner</b> Joe H. Cheng	<b>Art Unit</b> 3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2004 and 23 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. In response to the Preliminary Amendments filed on January 16, 2004 and June 23, 2004, claims 1-17 are pending.

#### ***Specification***

2. The term "This application is related to U.S. Provisional Patent Application No. 60/290,444, filed May 11, 2001 and is a continuation of International Application No. PCT/US02/14745, filed May 10, 2002." of paragraph [0001a] on Pg. 1 should be recited as -- This is a continuation application of International Application No. PCT/US02/14745, filed May 10, 2002, which claims the priority of U.S. Provisional Patent Application No. 60/290,444, filed May 11, 2001, all of which are incorporated herein by reference.--, so as to clarify the status.

#### ***Claim Rejections - 35 USC § 103***

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greanias et al (U.S. Pat. No. 5,007,085) in view of Inoue et al (U.S. Pat. No. 5,831,600) and further in view of Ohara et al (U.S. Pat. No. 6,297,812 B1). The broadly claimed structure can be interpreted as the remotely sensed personal stylus of Greanias et al. Figs. 1-8 of Greanias et al broadly discloses the interactive book system and method comprising a radio frequency (RF) scanning circuit having a matrix of conductive lines arranged as a plurality of spaced apart column conductive lines and a plurality of spaced apart row conductive lines (20, X<sub>1</sub>, X<sub>2</sub>, X<sub>3</sub>, X<sub>4</sub>, Y<sub>1</sub>, Y<sub>2</sub>, Y<sub>3</sub>, Y<sub>4</sub>) configured to detect the presence of a coordinate input device (such as stylus) enters the RF field generated by the RF scanning circuit (see Abstract, lines 7-11), the RF oscillator (76) to generate the RF signal that is input into the specific column conductive line, the input and output switching circuit (74) for sequentially routing or outputting the RF signal according to the predetermined input or output sequence, the bandpass processing circuit (84) for amplifying and filtering the coupled RF signals and the AC to DC converter (86), the microcontroller (94), and the memory (98, 100). It is noted that the teaching of Greanias et al does not specifically disclose the human finger (as per claims 1 and 14) as required. However, the teaching of Inoue et al broadly discloses that such feature of the coordinate input device (2) such as stylus (2-1, 52) or finger human finger (2-2, 52) are obvious and consider an obvious design choice, so as to

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select the designed area of interest for generating the corresponding information. In addition, it is also noted that the teaching of Greanias et al does not specifically disclose the audible output device (as per claim 1) for outputting the at least one of the audible messages (as per claims 1 and 14) which are stored in the memory (as per claim 1) as required. However, the teaching of Ohara et al broadly discloses that such features of the audible output device (28) for outputting the at least one of the audible messages which are stored in the memory (18, 86) are old and well known. Hence, it would have been obvious to one of ordinary skill in the art to modify the system and method of Greanias et al and Inoue et al with the feature of the audible output device as taught by Ohara et al as both Greanias et al, Inoue et al and Ohara et al are directed to the system and method, so as to provide the audio information of the touch area of the book. Further, it is further noted that the teachings of Greanias et al, Inoue et al and Ohara et al do not explicitly disclose that the RF signal has a frequency of approximately 100kHz (as per claim 10) or 18 VAC (as per claim 11) as required. However, such limitations of using the frequency of approximately 100kHz or 18 VAC for the RF signal are old and well known and are considered an arbitrary obvious design choice, so as to interactively detect the presence of a human finger when the finger enters the RF field generated by the RF scanning circuit for the interactive book reading system.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Preston et al (U.S. pat. 5,174,759) teaches the use of vertical and horizontal strip microphones to detect the presence of the coordinate input device on the book; Cobbly et al (U.S.

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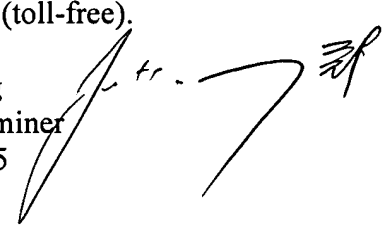
Pat. No. 5,546,538) discloses the system for processing handwriting written by user of a portable computer; Huffman et al (U.S. Pat. No. 5,661,635), Munyan (U.S. Pat. No. 5,761,485) and Hirayama (U.S. Pat. No. 6,507,342 B1) teach the touch screen display of a device for selecting the desired information displayed on the display; Flower (U.S. Pat. No. 5,877,458) disclose the surface position location system and method for determining the position of a user selected position; Yaotani et al (U.S. pat. No. 6,104,386) teaches the coordinate input device; Star et al (U.S. Pat. No. 6,347,813 B1) discloses the interactive probe system for interactive games and books; and Lynch et al (U.S. Pat. No. 6,668,156 B2), Wood et al (U.S. Pat. 6,608,618 B2) and Soto et al (U.S. Pat. No. 6,954,199 B2) teach the printed media receiving unit including platform for receiving the print media and touch on the interest area of the printed media to provide the audible information thereon.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe H. Cheng whose telephone number is (571)272-4433. The examiner can normally be reached on Tue. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571)272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joe H. Cheng  
Primary Examiner  
Art Unit 3715



Joe H. Cheng  
January 22, 2006